

REMARKS/ARGUMENTS

Applicant has reviewed and considered the Office Action mailed on May 18, 2007, and the references cited therewith.

No claims were amended, cancelled, or added. Claims 1-27 are pending in this application.

Applicant notes that the Examiner has identified claim 1-25 as pending. Applicant submits that this is incorrect. On October 21, 2005 Applicant responded to an Office Action dated August 10, 2005. In that response, Applicant filed new claims 26 and 27. As a result, claims 1-27 are pending and not claims 1-25 as indicated by the Examiner.

In addition, Applicant was not able to find the detailed basis for the rejection of claims 22 and 25 in the May 18, 2007 Final Office Action. Applicants request the basis for the rejection of claims 22, 25, 26 and 27, if any, in the next official communication.

§103 Rejection of the Claims

Claims 1, 2, 9, 12, 13, 23 and 24 were rejected under 35 USC § 103(a) as being unpatentable over Stephens (U.S. Pat. No. 5,380,046) in view of Smith (U.S. Pat. No. 5,410,827) and Moraw et al. (U.S. Pat. No. 4,324,421).

Claims 3 and 5 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw as applied to claims 1, 2, 9, 12, 13, 23 and 24 above and further in view of Killey (U.S. Pat. No. 5,342,672).

Claims 4, 6-8, 10, 11, 14-16, and 19-21 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw as applied to claims 1, 2, 9, 12, 13, 23 and 24 above and further in view of McConville et al. (U.S. Pat. No. 4,968,063).

Claims 17 and 18 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw et al. as applied to claims 1, 2, 9, 12, 13, 23 and 24 above and further in view of Killey and McConville et al.

Applicant respectfully traverses the rejections and repeats the arguments presented in response to the Office Action dated November 16, 2006 in support thereof.

The Examiner also presented several arguments in response to Applicant's Office Action response dated February 16, 2007. First, the Examiner argued that "applicant has not disclosed any criticality to the use of a 'fragile' or 'durable' layer in his assembly." In response, Applicant respectfully submits that they are unable to find a rule, law or discussion in the MPEP that disclosing the "criticality" of a claim element is a requirement of patentability. The MPEP does, however, discuss the situation where a claim that omits an element that applicant describes as an essential or critical feature of the invention would not comply with the written description requirement (see for example, MPEP 2163 I.B. and 2164.08(c)). The instant application, however, has not used the per se words "critical" or "essential" to describe an element in the specification. As such, Applicant is unaware of what rule or law, either substantive or procedural, the Examiner is submitting has not been met by the Applicant.

Second, the Examiner asserted that "[f]urther there is no recitation defining the function of the 'fragile' or 'durable' layer" (Final Office Action, page 6). It would appear that the Examiner is asserting that the present disclosure is lacking these recitations. Applicant respectfully traverses this assertion and submits that any number of recitations as to the function of the "fragile" and "durable" layer can be found through out the specification. For example, page 2, lines 24-26 provide that:

The term "fragile" as used in this application means a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing.

So, at least one "function" of the fragile layer, among others, is to be mechanically weak. In addition, page 2, lines 26-30 provide that:

As used in the application the term "durable" means a film that is free-standing film, without the necessity of a carrier layer and is thermally stable to withstand laminating or other processing temperatures, typically in the range of 100 to 150°C, as well as repeated handling, such as typical passport use.

So, at least one "function" of the durable layer, among others, is to be a free-standing film without the need for a carrier layer, and to be thermally stable to withstand laminating or other processing temperatures.

Applicant further provides that:

Advantageously, the present invention provides a transparent data sheet that contains one or more security features, including but not limited to the destruction of the fragile layer indicating tampering or attempted delamination. (page 3, lines 26-28)

So, an additional "function" of the fragile layer, among others, includes the ability to indicate tampering or attempted delamination of the transparent data sheet of the present disclosure.

In addition, the Examiner asserted that "[t]here is no recitation explaining its use in fraud detection or tampering" (Final Office Action, page 6). With respect to the instant patent application, Applicant respectfully submits that the words "fraud detection" are not recited in the pending claims. Applicant does, however, recite the word "tampering" in claim 19 to provide that the transparent data sheet further includes "a layer of hot melt adhesive that can not be reused without evidence of tampering" (pending claim 19). Based on the plain language of the claim, the word "tampering" is used in conjunction with a layer of hot melt adhesive that can not be reused (e.g., the hot melt adhesive having been sealed is separated then rejoined) without evidence of tampering with the hot melt adhesive.

The Examiner also stated that while "Stephens discloses two layers made of a thermoplastic material. It does not preclude a composite plastic material where different sections consist of different polymers to inherently provide layers of different/relative durability." (Final Office Action, page 6). It appears that the Examiner is relying, at least in part, upon an inherency argument in rejecting the present claims. Applicant respectfully traverses.

First, Applicant respectfully submits that the Examiner has provided no objective evidence or cogent technical reasoning to support the conclusion of inherency. Second, the Examiner has provided no extrinsic evidence that would suggest, be recognized by, or made clear to one skilled in the art that the missing descriptive matter (e.g., the "different sections [that could] consist of different polymers to inherently provide layers of different/relative durability") is necessarily present in the "plastic envelope 12" that "comprises dual rectangular plies 12', 12" of a transparent thermoplastic material. Finally, it would appear that the Examiner's assertions (e.g., "[i]t does not preclude a composite plastic material where different sections consist of different

polymers to inherently provide layers of different/relative durability") rely upon probabilities and/or possibilities, which are insufficient to support a proper inherency argument.

In responding to the Applicant's argument, the Examiner also asserted that "it is noted that the features upon which applicant relies (i.e., the specifics of the 'durable' and 'fragile' layers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181 26 USPQ2d 1057 (Fed Cir. 1993)."

As discussed, Applicant expressly recites the terms "fragile" and "durable" in the claims, where these terms are clearly and expressly defined in the specification. This is in contrast to the facts in In re Van Geuns cited by the Examiner, in which Van Geuns tried to limit the phrase "uniform magnetic field" of a magnetic assembly recited in the claim to that of an NMR or MRI apparatus among others generally provided in the specification. In other words, Van Geuns tried to limit the phrase recited in the claim by narrowly reading its meaning from a broader recitation in the specification. As such, In re Van Geuns is distinguished from the present case, as Applicant is not trying to limit the interpretation the terms "fragile" and "durable," as was the case in In re Van Geuns.

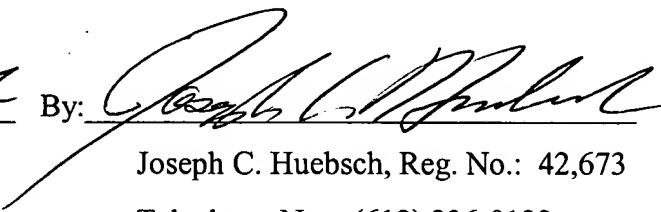
Based on the forgoing, reconsideration and withdrawal of the 103 rejection for independent claims 1, 2, 20, 21 23, and 24 as well as those claims that depend therefrom is respectfully requested.

CONCLUSION

Applicant submits that the claims are in condition for allowance and notification to that effect is earnestly requested.

The Examiner is invited to telephone the applicants' below signed attorney or Melissa E. Buss, Esq. at (651) 733-0649 to facilitate prosecution of this application.

Respectfully submitted,

July 18, 2007 By: 
Date Joseph C. Huebsch, Reg. No.: 42,673
Telephone No.: (612) 236-0122